

REMARKS

Claims 1-8 and 21-27 are pending in the present application. In the above amendments, claims 2, 22 and 24 have been amended, and new claims 25-48 have been added.

Applicant respectfully responds to this Office Action.

Claim Rejections – 35 USC § 101

Claims 21-24 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

In the Office Action, with respect to claims 21 and 22, the Examiner asserts that “[t]he language recites a ‘means for providing . . .’. This means covers at least software alone.” See, page 9. Applicants respectfully disagree. Means for claims “shall be construed to cover the corresponding structure . . . described in the specification” 35 U.S.C. § 112, ¶6. “The scope of a ‘means’ limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof.” See, MPEP 2106 V.A. Further, the USPTO may not disregard structure disclosed in the specification that corresponds to means (or step) plus function language. In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (emphasis added). By asserting that the claims can cover software alone, without any hardware, the Examiner is not following the clear directive in the statute for construing means for claims, namely, that means for claims “shall be construed to cover the corresponding structure . . . described in the specification.” Further, Applicants again assert that claims 21 and 22 are directed to “an apparatus.” Applicants assert that construing a claim to cover “software alone” is not a rational construction of a claim that is explicitly directed to “an apparatus.”

In the Office Action, the Examiner asserts that claims 23 and 24 encompass non-tangible “signal” media (Specification: page 4, lines 20-21), which is non-statutory. Quoting the specification, “in another embodiment, interface 104 comprises a wireless communication system for receiving software over-the-air.” See, Office Action, page 2. Applicants again assert that claims 23 and 24 are not directed to impermissible non-tangible or transitory signals. Instead, the claims are directed to a computer-readable medium, such as storage device 112. Claims to a computer readable medium are statutory. See, MPEP 2106.01, which cites In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Similarly, a claim

covering “a signal” is not statutory subject matter, but claims covering a “storage medium” were allowed. See, In re Nuijten, No. 2006-1371 (Fed. Cir. Sept. 20, 2007), fn. 6. “A transitory, propagating signal like Nuijten’s is not a ‘process, machine, manufacture, or composition of matter.’ . . . Thus, such a signal cannot be patentable subject matter.” See, MPEP 2106 IV.B. Further, the Applicants’ specification has no mention of a non-tangible signal media. Instead, the specification clearly references a tangible “wireless communication system.” Also, a search of the USPTO’s database of issued patent for the use of “computer readable medium” in the claims yields over 34,000 patents. Of those patents, over 10,000 include the word “wireless” in the corresponding specification. Finally, Applicant note that the Examiner failed to respond to the Applicant’s arguments filed on January 17, 2008, in support of the patentability of claims 23 and 24 under 35 U.S.C. §101.

Accordingly, claims 21-24 recite patentable subject matter, and the rejections under 35 U.S.C. §101 should be withdrawn.

Claim Rejections – 35 USC § 102

The Examiner rejected claims 2-3, 6, 22 and 24 as being allegedly anticipated by U.S. Patent No. 6,381,741 issued to Shaw. Applicants respectfully traverse this rejection.

Regarding amended claims 2, 22, and 24, Applicants respectfully submit that the Shaw patent does not disclose “updating said resident software with said available software if said resident software and said available software are not authenticated,” as now claimed. The Shaw patent only discloses overwriting a segment of code if the downloaded segment of code is authenticated and validated. See, column 5, lines 34-46. Therefore, since the Shaw patent does not disclose at least the above limitations, Applicants respectfully request the Examiner to withdraw the rejections of independent claims 2, 22, and 24, and of dependent claims 3 and 6.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1, 4-5, 21 and 23 as being allegedly unpatentable over the Shaw patent. Applicants respectfully submit that the Shaw patent does not disclose “updating said resident software with said available software if said resident software and said available software are not authenticated,” as now claimed. The Shaw patent only discloses overwriting a

segment of code if the downloaded segment of code is authenticated and validated. See, column 5, lines 34-46. Therefore, since the Shaw patent does not disclose or suggest at least the above limitations, Applicants respectfully request the Examiner to withdraw the rejections of claims 1, 4, 21 and 23.

The Examiner rejected claims 7-8 as being allegedly unpatentable over the Shaw patent in view of admitted prior art. Claims 7-8 depend on claims 2 and 6. Accordingly, for the reasons given above with respect to claim 2, the rejections of claims 7-8 should be withdrawn.

New Claims

Support for new claims 25-44 may be located in claims 1-8, and in the specification at page 4, lines 26-35. Applicant respectfully asserts that new claims 25-44 recite patentable matter as discussed above with respect to claims 1-8.

Support for new claims 45-48 may be located in the specification at page 5, lines 36-38. Applicant respectfully asserts that new claims 25-27 recite patentable features over the cited prior art and should be allowed.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: **July 21, 2008**

**By: /Won Tae C. Kim /
Won Tae C. Kim, Reg. # 40,457
(858) 651 - 6295**

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 658-5787
Facsimile: (858) 658-2502